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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,979	02/12/2001	Parula Mehta	98,375-C	1569

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EXAMINER

LUCAS, ZACHARIAH

ART UNIT	PAPER NUMBER
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1648

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DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/701,979

Applicant(s)

MEHTA ET AL.

Examiner

Zachariah Lucas

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-- Th MAILING DATE of this communication appears on the cov r sh t with the correspondence addr ss --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2, and 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Status of the Claims*

1. Claims 1, 2, and 4-12 are pending and under consideration. Claims 1-9 were rejection in the office action mailed on August 5, 2002 (the prior action). In the response to that action, filed February 6, 2003 (the Response), Applicant cancelled claim 3, amended claims 1 and 6, and added claims 10-12.

2. The Art Unit location of your application, and the examiner to whom the case has been docketed in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Zachariah Lucas in Art Unit 1648.

### *Claim Rejections - 35 USC §§ 112 and 101*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **(Prior Rejection- Withdrawn)** Claims 1 and 6 were rejected in the prior action under 35 U.S.C. 112, second paragraph, as being indefinite due to inclusion of the open language of comprising where describing a solution formed by the combination of two constituents. In view of the amendments made by the applicant, the rejection is withdrawn.

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5. **(Prior Rejection Withdrawn)** Claim 1 was rejected in the prior office action under 35 U.S.C. 112, second paragraph, as being indefinite because the claim was to a method wherein no steps of the method were described. In view of the amendments to the claims, the rejection is withdrawn.

6. **(Prior rejection-Withdrawn)** Claim 1 was rejected in the prior office action under 35 U.S.C. 101 because the claim was drawn to nonstatutory subject matter. The claim was drawn to a method wherein no steps were described. In view of the amendments to the claim, the rejection is withdrawn.

**(Prior rejection-Withdrawn)** Claim 3 was rejected in the prior office action as indefinite for using improper Markush claim language. The claim was written such that it was not clear what was encompassed by the claim. In view of the cancellation of the claim, the rejection is withdrawn. While the subject matter of claim 3 has been divided and reintroduced in to claims 10-12, the Examiner agrees with the applicant's traversal of the rejection. Thus, the rejection is not applied against these claims.

7. **(Prior Rejection-Withdrawn)** Claim 4 was rejected in the prior office action under 35 U.S.C. 112, second paragraph, as being indefinite because the claim it was unclear what comprises a fungi stain, and because it was unclear what if the stain names referred to individual

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stains, or to types of stains. Applicant's traversal was persuasive. The rejection is therefore withdrawn.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **(Prior Rejection- Withdrawn)** Claims 1-3, and 5 were rejected in the prior action under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent 3,431,886) in view of Copeland et al. (U.S. Patent 5,650,327). These claims read on automated methods of staining biological materials comprising a) providing a first a second stable solution, which form an unstable staining solution when combined, b) providing a slide with a biological material to be stained thereon, and c) sequentially applying the first and second stable solutions to the biological material using an automated delivery system. In view of the cancellation of claim 3, the rejection is withdrawn to the extent that it applied to this claim. Likewise, the rejection is extended to apply to claims 10-12, which cover the same subject matter as claim 3.

The Applicant traverses this rejection on the grounds that neither of the two references teaches the combination of two stable solutions to form an unstable staining solution. This argument is persuasive. The rejection is therefore withdrawn.

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10. **(Prior Rejection- Maintained)** Claims 1-9 were rejected in the prior action under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Copeland, and in view of McManus et al. (Staining Methods, Histologic and Histochemical, Paul B. Hoeber, Inc., New York, 1960. The claims have been described above. The applicant traverses this rejection with the same argument as applied above. The argument is not found persuasive.

In the above rejection, as the applicant pointed out, neither of the cited references taught the combination of two stable solutions to form an unstable staining solution. However, the Copeland reference did teach the sequential application of several solutions that cumulatively allow histologic study of the sample. See, column 20, lines 24-42. Further, in describing the apparatus and method disclosed in the patent, Copeland generally refers to the solutions brought into contact with the sample as reagents. This implies that any reagent known in the art may be applied using the method and apparatus disclosed in the reference. In view of the cancellation of claim 3, the rejection is withdrawn to the extent that it applied to this claim. Likewise, the rejection is extended to apply to claims 10-12, which cover the same subject matter as claim 3.

As was described in the prior action, McManus describes the combination of two stable solutions to form an unstable staining solution. Pages 134, 135, 138, 240, and 368. Therefore, McManus teaches the use of unstable stains formed by the combination of two stable solutions. The reference also demonstrates that such stains were well known in the art. As McManus teaches the stains, and Copeland teaches a method and apparatus for the sequential application of constituents of a multi-solution stain to a material, it would have been obvious to one of ordinary skill in the art to combine the teachings such that the apparatus of McCormick and Copeland is

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used to sequentially apply the stable solutions of McManus to the sample such that an unstable stain is formed with, and can react with, the biological material.

The applicant's traversal does not consider the teachings of McManus. It is therefore traversing the rejection, which is based on three references, on the insufficiency of only two of the references. This may be equated with a traversal of a rejection based on multiple rejections by attacking only the teachings of the individual references, and not the cumulative teachings of all the cited references. It has been established in the law that "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." In re Young, 159 U.S.P.Q. 725, at 728 (CCPA, 1968); and In re Keller, Terry, and Davies, 208 USPQ 871, at 882 (CCPA, 1981). As the applicant's traversal has not considered the teachings of McManus as well as those of Copeland and McCormick, the applicant's traversal is not found persuasive. The rejection is therefore maintained against claims 1, 2, and 4-12 for the reasons stated above, and for the reasons of record.

### ***Conclusion***

11. No claims are allowed.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 703-308-4240. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Z. Lucas  
Patent Examiner  
April 17, 2003

  
JAMES HOUSEL 4/21/03  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600